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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,645	04/02/2004	Michael D. Pashley	US000386A	1083
24737	7590	08/18/2006	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS			NEGRON, ISMAEL	
P.O. BOX 3001			ART UNIT	
BRIARCLIFF MANOR, NY 10510			PAPER NUMBER	
			2875	

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	10/816,645		PASHLEY ET AL.	
	Examiner		Art Unit	
	Ismael Negron		2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on August 3, 2006 has been entered. Claims 19, 22 and 38 have been amended. No claim has been cancelled, or added. Claims 19-38 are still pending in this application, with claims 19, 37 and 38 being independent.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "6" has been used to designate different parts in different embodiments. See figures 1 (used to reference round rod), 4 (used to reference square rod) and 5 (used to reference generally square rod with round edges). While all the referenced parts are indeed rods, they are clearly different parts (i.e. differently shaped rods).

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rod having a combination of straight and curved edges that vary in configuration along the length of the rod (as recited in Claim 33) must be shown or the feature(s) canceled from the claims. No new matter should be entered.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

Non-Statutory

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 19 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,783,269 (PASHLEY et al.) in view of U.S. Patent No. 4,954,931 (HASSLER, JR.).

6. Patented Claim 1 of PASHLEY et al. recites all the limitations of the instant claim, except the rod permitting substantial total internal reflection (TIR), the outcoupling material being distributed along an angular width in such a way as to ensure uniform light distribution along the length of the rod.

7. HASSLER, JR. discloses a side-illuminating device having a window 59 formed on an outer surface of a rod 11, the angular width of the window 59 being determined to ensure uniform light distribution along the length of the rod 11. See Figure 3 and column 3 (lines 36-39) of HASSLER, JR.

8. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to adjust the angular width of the outcoupling material of PASHLEY et al. to ensure uniform light distribution along the length of the rod, as per the teachings of HASSLER, JR. (column 3, lines 36-39). Regarding the rod permitting substantial total internal reflection (TIR), one of ordinary skill in the art at the time the claimed invention was made would have recognized the patented rod of PASHLEY et

al. as inherently permitting substantially total internal reflection” limitation, as such rod is claimed as permitting total internal reflection.

9. Claim 20 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 2 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

10. Claim 21 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 3 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

11. Claim 22 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 4 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

12. Claim 23 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 5 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

13. Claim 24 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 6 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

14. Claim 25 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 7 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

15. Claim 26 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 8 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

16. Claim 27 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 9 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

17. Claim 28 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 10 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

18. Claim 29 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

19. Claim 30 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 12 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

20. Claim 31 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 13 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

21. Claim 32 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 14 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

22. Claim 33 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 15 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

23. Claim 34 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 16 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

24. Claim 35 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 17 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

25. Claim 36 is rejected on the ground of nonstatutory obviousness-type double patenting as claiming substantially the same invention as that of Claim 18 of prior U.S. Patent No. 6,783,269. See previous sections 5-8.

26. Claim 37 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,783,269 in view of

U.S. Patent No. 4,954,931 (HASSLER, JR.). Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would have recognized the structural limitations of the patented LED light source of PASHLEY et al., as modified by HASSLER, JR., as inherently disclosing the instantly claimed method. See previous sections 5-8.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

27. Claim 37 is rejected under 35 U.S.C. 102(e) as being anticipated by MASUTANI et al. (U.S. Pat. 6,488,397).

28. MASUTANI et al. discloses a side-emitting device having:

- **providing a light transmitting rod (as recited in Claim 37) with an outcoupling material along its side, column 2, lines 56-59;**
- **the rod permitting substantially total internal reflection (as implied in Claim 37), column 2, lines 60-63;**

- **controlling the width of the outcoupling material to achieved a desired angular distribution of light leaving the side of the rod (as implied in Claim 37), as evidenced by column 2, lines 34-38; and**
- **illuminating the rod with a light source (as implied in Claim 37), column 2, lines 53-56.**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 19-30, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over MASUTANI et al. (U.S. Pat. 6,488,397) in view of HASSLER, JR. (U.S. Pat. 4,954,931).

30. MASUTANI et al. discloses a side-emitting device having:

- **a light source (as recited in claims 19 and 38), Figure 1, reference number 3;**
- **a light transmitting rod (as recited in claims 19 and 38), Figure 1, reference number 4;**

- **the rod permitting substantially total internal reflection (as recited in claims 19 and 38), column 2, lines 60-63;**
- **an outcoupling material (as recited in claims 19 and 38), Figure 2, reference number 5;**
- **the outcoupling material being affixed to the outer surface of the rod (as recited in claims 19 and 38), column 2, lines 56-59;**
- **the width of the outcoupling material controlling the angular distribution of light leaving the side of the rod (as recited in claims 19 and 38), inherent;**
- **the light source including a plurality of LED (as recited in Claim 20), column 4, lines 1-3;**
- **the plurality of LED including at least a red, a green and a blue LED (as recited in Claim 21), column 4, lines 16-18;**
- **the red, green and blue LED when mixed generating white light (as recited in Claim 21), inherent;**
- **the red, green and blue LEDs being capable of being mixed to generate white light chromaticity (as recited in Claim 22), inherent;**
- **the red, green and blue LEDs being capable of being mixed to generate dynamic color effects (as recited in Claim 23), inherent;**
- **the rod being a flexible rod (as recited in Claim 24), column 2 and 3, lines 60-67 and 1-5, respectively;**

- **the rod being a rigid rod (as recited in Claim 25), column 2 and 3, lines 60-67 and 1-5, respectively;**
- **the outcoupling material being a paint (as recited in Claim 26), column 3, line 6;**
- **the paint being white paint (as recited in Claim 27), column 3, lines 6-8;**
- **the white paint being distributed in such a way as to control the angular distribution of the light leaving the rod (as recited in Claim 28), as evidenced by column 3, lines 38-45;**
- **the white paint being distributed in such a way as to ensure uniform light distribution along the length of the rod (as recited in Claim 29), as evidenced by column 3, lines 38-45; and**
- **an elliptical rod (as recited in Claim 30), as seen in Figure 2.**

31. MASUTANI et al. discloses all the limitations of the claims, except the outcoupling material being distributed along an angular width in such a way as to ensure uniform light distribution along the length of the rod (as recited in claims 19 and 38).

32. HASSLER, JR. discloses a side-illuminating device having:

- **a light source (as recited in claims 19 and 38), Figure 3, reference numbers 17 and 19;**
- **a light transmitting rod (as recited in claims 19 and 38), Figure 1, reference number 4;**

- **the rod permitting substantially total internal reflection (as recited in claims 19 and 38), as evidenced by column 2, lines 64-69;**
- **an outcoupling portion (as recited in claims 19 and 38), Figure 3, reference number 59;**
- **the outcoupling portion being formed on the outer surface of the rod (as recited in claims 19 and 38), column 3, lines 16-18;**
- **the width of the outcoupling portion controlling the angular distribution of light leaving the side of the rod (as recited in claims 19 and 38), inherent;**
- **the width of the outcoupling portion being determined to ensure uniform light distribution along the length of the rod (as recited in claims 19 and 38), column 3, lines 36-39.**

33. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to adjust the angular width of the outcoupling material of MASUTANI et al. to ensure uniform light distribution along the length of the rod, as per the teachings of HASSLER, JR. (column 3, lines 36-39).

34. Regarding the use of the verb **can** (as used in claims 22 and 23), the applicant is once again advised that it has been held that the recitation that an element is capable of performing a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In addition, note the use of **when** in Claim 21.

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35. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over MASUTANI et al. (U.S. Pat. 6,488,397) in view of HASSLER, JR. (U.S. Pat. 4,954,931).

36. MASUTANI et al. and HASSLER, JR. individually disclose, or suggest when combined (see previous sections 30-33), all the limitations of the claims, except:

- the rod being a square rod (as recited in Claim 31);
- the rod being having combination of square and curve edges (as recited in Claim 32); and
- the combination of square and curve edges varying along the length of the rod (as recited in Claim 33).

37. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to shape the rod of the device of MASUTANI et al. and HASSLER, JR. as a square rod (as recited in Claim 31), or as a rod having combination of square and curve edges (as recited in Claim 32), such combination of edges varying along the length of the rod (as recited in Claim 33), since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). In this case, one of ordinary skill in the art would have been motivated to select a specific shape as necessitated by the particular requirements of a specific application, as admitted by the applicant (see pages 5 and 6, lines 19-24 and 1-4, respectively).

38. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over MASUTANI et al. (U.S. Pat. 6,488,397) in view of HASSLER, JR. (U.S. Pat. 4,954,931), as applied to claim 19 above, further in view of ASHALL (U.S. Pat. 5,390,466).

39. MASUTANI et al. and HASSLER, JR. individually disclose, or suggest when combined (see previous sections 30-33), all the limitations of the claims, except the outcoupling material including a combination of white paint and fine dots with varying packing density (as recited in Claim 34).

40. ASHALL discloses a side-emitting panel having:

- **a light source (as recited in Claim 19)**, Figure 1, reference number 21;
- **a light transmitting panel**, Figure 1, reference number 10;
- **the panel permitting substantially total internal reflection (as recited in Claim 19)**, as evidenced by Figure 1;
- **an outcoupling material (as recited in Claim 19)**, Figure 1, reference number 13;
- **the outcoupling material being affixed to the outer surface of the panel (as recited in Claim 19)**, column 3, lines 15-17;
- **the outcoupling material including a combination of white paint and fine dots (as recited in Claim 34)**, column 3, lines 56-59; and

- **the combination of white paint and fine dots having a varying packing density (as recited in Claim 34), column 3, lines 59 and 60.**

41. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include a combination of white paint and fine dots with varying packing density (as recited in Claim 34) as the outcoupling material of the device of MASUTANI et al. and HASSLER, JR., to be able to enhance uniform light emission from the side of the rod, as per the teachings of ASHALL.

42. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over MASUTANI et al. (U.S. Pat. 6,488,397), as applied to claim 19 above, further in view of REID et al. (U.S. Pat. 6,267,492).

43. MASUTANI et al. and HASSLER, JR. individually disclose, or suggest when combined (see previous sections 30-33), all the limitations of the claims, except a mirror located at the end of the rod away from the light source (as recited in Claim 35), such mirror reflecting light that travels the entire length of the rod (as recited in Claim 36).

44. REID et al. discloses a side-emitting device having:

- **a light source (as recited in Claim 19), Figure 1, reference number 10;**

- **a light transmitting rod (as recited in Claim 19), Figure 1, reference number 20;**
- **the rod permitting substantially total internal reflection (as recited in Claim 19), column 5, lines 36-43;**
- **an outcoupling material (as recited in Claim 19), Figure 3B, reference number 226;**
- **the outcoupling material being affixed to the outer surface of the rod (as recited in Claim 19), column 6, lines 33-36; and**
- **a mirror (as recited in Claim 35), Figure 6A, reference number 626;**
- **the mirror being located at the end of the rod away from the light source (as recited in Claim 35), column 9, lines 50 and 51; and**
- **the mirror reflecting light that travels the entire length of the rod (as recited in Claim 36), column 9, lines 50-54.**

45. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the end mirror of REID et al. in the rod of the device of MASUTANI et al. and HASSLER, JR., to be able to reflect back along the rod light that traveled the entire length of the rod, as per the teachings of REID et al.

Response to Arguments

46. Applicant's arguments with respect to claims 19 and 38 have been considered but are moot in view of the new ground(s) of rejection.

47. Regarding the Examiner's rejection of claims 20-36, the applicant present no arguments, except stating that such claims depend directly or indirectly from independent Claim 19 and would be allowable when/if the independent claim is allowed.

Conclusion


48. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

49. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

50. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (571) 273-8300.

51. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



THOMAS M. SEMBER
PRIMARY EXAMINER

Ismael Negron
Examiner
AU 2875